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09/333,383	06/15/1999	BOMAN IRANI	5181-29600	4054

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EXAMINER

DINH, KHANH Q

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 23

Application Number: 09/333,383
Filing Date: June 15, 1999
Appellant(s): IRANI, BOMAN

B. Noel Kivlin
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on February 17, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The amendment after final rejection filed on 12/22/2003 has been entered.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 5-38 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5809415	ROSSMANN et al	9-1998
6253122	RAZAVI et al	6-2001

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 5-18 and 21-38 are rejected under 35 U.S.C. 102(e). This rejection is set forth in prior Office Action, Paper No. 17.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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2. Claims 5-18 and 21-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Rossmann US pat. No.5,809,415.

As to claim 5, Rossmann discloses a method for sending content to a small footprint device (portable device or PDA 101, 102 fig.1) comprising:

connecting the small footprint device (using 100 or 101 of fig. 1) to provide information to the computer network) to a first network (Cellular Telephone Network 110 fig. 1) communicating with a service accessible from the first network (110 fig.1) to send information to the service accessible from the first network storing the information (see figs. 1 and 2A, abstract, col.8 line 56 to col.8 line 60 and col.12 lines 5-41).

a service accessible from a second network (111 fig.1) receiving the information from the service accessible from the first network (110 fig.1) (i.e., each two-way data communication devices 100, 101 or 102 fig.1 can be configured to transmit and receive data from any desired combination of computers on computer networks 120, 130, 140 through 110 and 111 of fig.1), the service accessible from the second network generating content based on the information (i.e., using an application on the server computer on the computer network that has an interface two-way pager network), wherein the service accessible from the second network (111 fig.1) communicating with the small footprint device for sending the content to the small foot print device (i.e., sending and processing information received to the client devices in response to user selections, see col.8 line 46 to col.9 line 54, col.10 line 14 to col.11 line 56 and col.15 line 36 to col.16 line 63).

As to claims 6, 26 and 33, Rossmann discloses displaying content [displaying selection by users on screen display device (202 fig.2C), see figs.2A-2C, col.13 lines 8-61].

As to claims 7, 27 and 34, Rossmann further discloses executing a service for displaying dynamically generated content and displaying dynamically displaying the content (in response to a user request, generating a purchase order in a display screen, see col.14 line 6 to col.15 line 34).

As to claims 8, 9, 28 and 35, Rossmann discloses rejecting and filtering the content (using the request fields including only information such as lists of the contents types acceptable to the clients, see figs. 8A and 8B, col.25 line 5 to col.26 line 59).

As to claims 10 and 11, Rossmann discloses the first network and second network are LAN and the service accessible from the first and second network executing on a computer system on the first and second network (LAN 130 fig.1) (see fig.1 and col.10 line 14 to col.11 line 64 and col.14 lines 6-67).

As to claims 12 and 13, Rossmann discloses sending information regarding a user of the small footprint device (information about user's requests) to the service accessible from the first and second network and the service accessible from the first network, said service accessible from the first network generating content based on the information comprising the service accessible from the second network generating content based

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on the information regarding the user of the small footprint device including advertising content (generating content information such as XYZ sales service, purchase orders, and providing data/information from the servers to/from client devices, see figs. 4's, col.3 lines 27-56, col.15 line 36 to col.16 line 63 and col.18 line 5 to col.19 line 41).

As to claim 14, Rossman discloses sending one or more of: demographic data of the user, buying habits of the user, web browsing of the users and geographic of the user [using the request fields including only information about users such as lists of the contents types, series of choices of services (market orders, stock quotes) acceptable to the clients, see figs. 8A and 8B, col.18 line 11 to col.19 line 41 and col.25 line 5 to col.26 line 59].

As to claims 15, 29 and 36, Rossmann discloses sending information specifying one or more items the user has purchased and generating the personal advertising content based on the user's store (generating a series of choices of services such as market orders, stock quotes) available to users on users' screens, see figs. 8A and 8B, col.18 line 11 to col.19 line 41 and col.25 line 5 to col.26 line 59).

As to claims 16, 17 and 32, Rossmann discloses specifying a store in which a user of the small footprint device is currently located and generating content based on the user's store [generating a series of choices of services (market orders, stock quotes)

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available to users on users' screens, see col.17 lines 7-55 and col.18 line 11 to col.19 line 41].

As to claim 18, Rossmann discloses automatically connecting to the first network without a user requesting the small footprint device to connect to the first network (automatically displaying a list of choices for the user from the HTTP server, see col.23 line 3 to col.24 line 60 and col.25 line 53 to col.26 line 59).

As to claims 21 and 23, Rossmann discloses a first service executing on the small footing device communicating with the service accessible from the first and second network to send the information from the first and second network [providing new and updated capabilities by modifying the applications on the server computers and using work translator (500 fig.5) to provide a directory service to users, see figs.1, 5, col.10 line 14 to col.11 line 64, col.14 lines 6-67 and col.19 line 20 to col.20 line 44].

Claim 22 is rejected for the same reasons set forth in claim 5. As to the added limitation, Rossmann further discloses the computer system connected though LAN [using LAN (130 fig.1), see fig.1 and col.10 line 14 to col.11 line 64 and col.14 lines 6-67].

As to claim 30, Rossman discloses a method for sending content to a small footprint device (cellular phone 100 fig.1) comprising:

connecting the small footprint device (100 or 101 of fig.1) to a local area network LAN (providing information to the computer network LAN 130 fig.1) to a first network (Cellular Telephone Network 110 fig. 1) communicating with a first service executing on LAN to send to the first service (see figs. 1 and 2A, abstract, col.8 line 56 to col.8 line 60).

the first service executing on the LAN generating the content based on the information and communicate with the small footprint device to send the content to the small footprint device to send the information to the footprint device (i.e., sending and processing information received to the client devices in response to user selections, see col.8 line 46 to col.9 line 54, col.10 line 14 to col.11 line 56 and col.15 line 36 to col.16 line 63).

As to claims 24, 25 and 31, Rossman discloses storing information on a computer system and a file system is LAN (LAN 130 fig.1) (see fig.1 and col.10 line 14 to col.11 line 64 and col.14 lines 6-67).

As to claims 37 and 38, Rossman discloses system comprising:

A small footprint device (100 or 101 fig.1) and a local area network (LAN 130 fig.1) including a first service operable connecting the small footprint device (using 100 or 101 of fig.1 to provide information to the computer network) and a second service operable to communicate with the small footprint device, wherein the small device is

operable to connect to the LAN to send information to the first service (see figs. 1 and 2A-2C, abstract, col.8 line 56 to col.8 line 60).

Wherein the first service operable on LAN, the second service operable to retrieve the stored information and generating content based on the information and send the content to the small footprint device (i.e., sending and processing information received to the client devices in response to user selections see col.8 line 46 to col.9 line 54, col.10 line 14 to col.11 line 56 and col.15 line 36 to col.16 line 63) and the small footprint device is operable to display the content [displaying the information on the (100 or 101 of fgi.1] (see col.14 line 6 to col.15 line 34).

Claims 19 and 20 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 17.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rossman US pat. No.5,809,415 in view of Razavi et al, US pat. No.6,253,122.

Rossman's teachings still applied as in item 4 above. Rossman does not specifically disclose a Jini network. However, the Jini network is generally well known in the art as disclosed by Razavi (see abstract, col.9 line 22 to col.10 line 31). It would have been obvious to one of the ordinary skill in the art at the time the invention was made to implement a well-known network such as Jini network of Razavi into the computer system of Carnegie to process data information because it would have provided more utilizations of the computer system in the network environment.

(11) Response to Argument

Appellant has chosen to group the claims into 13 groups:

Group A: Claims 5-7, 10, 11, 18 and 21.

Group B: Claims 8 and 9.

Group C: Claims 12, 13 and 17.

Group D: Claims 14-16.

Group E: Claims 19 and 20.

Group F: Claims 22-26.

Group G: Claims 27 and 28.

Group H: Claim 29.

Group I: Claims 30-33.

Group J: Claims 34 and 35.

Group K: Claim 36.

Group L: Claim 37.

Group M: Claim 38.

Regarding Group A, pages 5-6 of the Appeal Brief are directed to these claims.

* Applicant asserts that the Rossmann reference does not disclose connecting the small footprint device to provide information to the computer network) to a first network communicating with a service accessible from the first network to send information to the service accessible from the first network storing the information and a service accessible from a second network receiving the information from the service

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accessible from the first network the service accessible from the second network generating content based on the information, wherein the service accessible from the second network communicating with the small footprint device for sending the content to the small foot print device; and the content does not generate from a redirected response to the footprint device.

Examiner respectfully disagrees. Rossman discloses a two-way communication device such as data ready telephone, two-way pager communicates with a server computer on a computer network or corporate network, Internet, LAN or any combination of networks. In this particular case, Rossmann discloses connecting the small footprint device (using 100 or 101 of fig. 1) to provide information to the computer network) to a first network (Cellular Telephone Network 110 fig. 1) communicating with a service accessible from the first network (110 fig.1) to send information to the service accessible from the first network storing the information (processing information from the network (110 fig.1) to the client (100 fig.1), see figs. 1 and 2A, abstract, col.8 line 56 to col.8 line 60 and col.12 lines 5-41). Furthermore, Rossmann further discloses a service accessible from a second network (111 fig.1) receiving the information from the service accessible from the first network (110 fig.1) (i.e., each two-way data communication devices (100, 101 or 102 fig.1) can be configured to transmit and receive data from any desired combination of computers on computer networks 120, 130, 140 through 110 and 111 of fig.1), the service accessible from the second network generating content based on the information (i.e., using an application on the server

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computer on the computer network that has an interface two-way pager network), wherein the service accessible from the second network (111 fig.1) communicating with the small footprint device for sending the content to the small foot print device. For example, Rossmann discloses sending and processing data information from a server communicating with the client devices in response to user selections (see col.8 line 46 to col.9 line 54, col.10 line 14 to col.11 line 56 and col.15 line 36 to col.16 line 63).

Regarding Group B, page 6 of the Appeal Brief is directed to these claims.

Appellant asserts that the cited reference does not disclose “the small footprint device rejecting and filtering the content”.

Examiner respectfully points out that Rossmann discloses using the request fields including only information such as lists of the contents types acceptable to the clients, listing of data encoding types and encryption scheme information for the server and Internet mail address of the user accessing server (see figs. 8A and 8B, col.25 line 5 to col.26 line 59).

Regarding Group C, pages 6-7 of the Appeal Brief are directed to these claims.

Appellant asserts that the Rossmann reference does not disclose information “regarding a user of the small footprint device”.

Examiner respectfully points out that Rossmann discloses information about user's requests including content information such as XYZ sales service, purchase orders, and providing user data/information to the servers to/from client devices (see

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figs. 4's, col.3 lines 27-56, col.15 line 36 to col.16 line 63 and col.18 line 5 to col.19 line 41).

Regarding Group D, pages 7-8 of the Appeal Brief are directed to these claims.

Appellant asserts that the Rossmann reference does not disclose sending one or more of: demographic data of the user, buying habits of the user, web browsing of the users and geographic of the user.

Examiner respectfully points out that Rossmann discloses using the request fields including only information about users such as lists of the contents types, series of choices of services (market orders, stock quotes) available and acceptable to the clients (see figs. 8A and 8B, col.18 line 11 to col.19 line 41 and col.25 line 5 to col.26 line 59).

Regarding Group E, page 8 of the Appeal Brief is directed to these claims.

Appellant asserts that the motivation in combination of references of Rossmann and Razavi is hindsight.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

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reconstruction is proper. See In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Regarding Group F, pages 8-9 of the Appeal Brief are directed to these claims.

Appellant asserts that the Rossmann reference does not disclose a first service executing on LAN and second service executing on LAN.

Examiner respectfully points out that Rossmann discloses the computer server (121 fig.1) connected though LAN [using LAN (130 fig.1) as well as the computer server (131 fig.1)] for processing communications between client devices (100 or 101 fig.1) and networks (see fig.1 and col.10 line 14 to col.11 line 64 and col.14 lines 6-67).

Regarding Group G, page 9 of the Appeal Brief is directed to these claims.

Appellant asserts that the Rossmann reference does not disclose rejecting and filtering the content.

Examiner respectfully points out that Rossmann discloses using the request fields including only information such as lists of the contents types acceptable to the clients and a listing of data encoding types and encryption scheme information for the server and Internet mail address of the user accessing server (see figs. 8A and 8B, col.25 line 5 to col.26 line 59).

Regarding Group H, pages 9-10 of the Appeal Brief are directed to these claims.

Appellant asserts that the Rossmann reference does not disclose sending information specifying one or more items the user has purchased and generating the personal advertising content based on the user's store.

Examiner respectfully disagrees. Rossmann discloses generating a series of choices of services such as market orders, stock quotes and access control for paying Internet services available to users on users' screens (see figs. 8A and 8B, col.18 line 11 to col.19 line 41 and col.25 line 5 to col.26 line 59).

Regarding Group I, page10 of the Appeal Brief are directed to these claims.

Appellant asserts that the Rossmann reference does not disclose the limitations in claims 30-33 for at least the reasons given in regard to claims 5-7, 10, 11, 18 and 21.

Examiner respectfully points out the response to the Appellant's assertions set forth above for claims 5-7, 10, 11, 18 and 21.

Regarding Group J, pages 10-11 of the Appeal Brief are directed to these claims.

Appellant asserts that the Rossmann reference does not disclose rejecting and filtering the content.

Examiner respectfully points out that Rossmann discloses using the request fields including only information such as lists of the contents types acceptable to the clients and a listing of data encoding types and encryption scheme information for the

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*server and Internet mail address of the user accessing server (see figs. 8A and 8B,
col.25 line 5 to col.26 line 59).*

Regarding Group K, page 11 of the Appeal Brief is directed to these claims.

Appellant asserts that the Rossmann reference does not disclose the first service generating the personal advertising content based on the user's store.

Examiner respectfully disagrees. Rossmann discloses that the client device can be used for generating a series of choices of services such as market orders, stock quotes and access control for paying Internet services available to users on users' screens (see figs. 8A and 8B, col.18 line 11 to col.19 line 41 and col.25 line 5 to col.26 line 59).

Regarding Group L, page 11 of the Appeal Brief is directed to these claims.

Appellant asserts that the Rossmann reference does not disclose the limitations in claim 37 for at least the reasons given in regard to claims 5-7, 10, 11, 18 and 21.

Examiner respectfully points out the response to the Appellant's assertions set forth above for claims 5-7, 10, 11, 18 and 21.

Regarding Group M, pages 11-12 of the Appeal Brief are directed to these claims.

Appellant asserts that the Rossmann reference does not disclose the limitations in claim 38 for at least the reasons given in regard to claims 5-7, 10, 11, 18 and 21.

Examiner respectfully points out the response to the Appellant's assertions set forth above for claims 5-7, 10, 11, 18 and 21.

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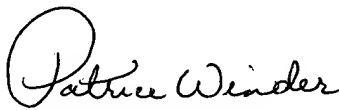
For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,

Khanh Dinh
Examiner
Art Unit 2151

April 4, 2004

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